

Patent Appl. No. 10/824,412  
Response Dated September 14, 2005  
Reply to Office Action dated June 14, 2005

### **REMARKS/ARGUMENTS**

By the present amendment, claims 1, 5, 6 and 7 have been amended and previous claim 4 has been canceled. As a result, claims 1-3 and 5-12 are pending in the present application. The amendments to the claims have been made without prejudice and without acquiescing to any of the Examiner's objections. Applicant reserves the right to pursue any of the deleted subject matter in a further divisional, continuation or continuation-in-part application. No new matter has been entered by the present amendment and its entry is respectfully requested.

The Official Action dated June 14, 2005 has been carefully considered. It is believed that the amended specification and claims and the following comments represent a complete response to the Examiner's rejections and place the present application in condition for allowance. Reconsideration is respectfully requested.

### **Oath or Declaration**

The Examiner has objected to the oath or declaration as it does not identify the city of residence of each inventor. We disagree as the declaration that was submitted was on Form PTO/SB/01A which is issued by the Patent Office. On that form there is no need to provide the addresses of the inventors as it is accompanied by an application data sheet. We confirm that we did file an application data sheet with the Form PTO/SB/01A and we enclose a second copy herewith. There is also no requirement that the signatures on Form PTO/SB/01A are dated.

In view of the foregoing, we respectfully request that the objections to the oath or declaration be withdrawn.

### **Disclosure**

The Examiner has objected to the disclosure at page 1 and requested that the patent number for the allowed application 09/822,823 is provided. In response, the disclosure has been amended at page 1, paragraph 1 to insert reference to United States Patent No. 6,750,326.

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**Double Patenting**

The Examiner has rejected claims 1-3, 7, 9 and 12 under 35 U.S.C 101 as claiming the same invention as United States Patent No. 6,448,075. By the present amendment, the claims have been amended so that they do not claim the same invention as the prior patent.

The Examiner has also objected to claims 1, 4-6, 8 and 10-11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 26-27 and 29 of United States Patent No. 6,448,075. Applicant will file a terminal disclaimer to overcome these objections once we receive an indication that the present application is allowable.

**35 U.S.C 102**

The Examiner has objected to claims 4-6, 8 and 10 under 35 U.S.C. 102(b) as being anticipated by Peters et al. (Proceed. Amer. Assoc. Cancer Res., Vol. 41, p. 589, March 2000). We respectfully disagree with the Examiner for the reasons that follow.

Peters et al. describes a composition for enriching epithelial tumor cells that comprises a composition of antibodies to CD2, CD16, CD19, CD36, CD38, CD45 and CD66b. This combination of antibodies was taught in the provisional application serial No. 60/193,371 filed March 31, 2000. Peters et al. was published in April 2000, after a priority date had been established for the antibody composition disclosed in Peters et al. Further as noted above, the claims of the present case have been amended to recite a selection of antibodies for enriching and recovering non-hematopoietic cells in a sample. Specifically, the combination of antibodies to CD45 and CD66b was not taught in Peters.

We additionally note that the Peters et al. reference was not cited by the Examiner during prosecution of the parent case USSN 09/822,833. Specifically, in the office action dated September 24, 2003, the Examiner states on page 3: "this reference will not be cited, as was Peters et al. (FASEB Journal, April 2000), because the reference has an authorship

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identical to the instant invention". As a result, this reference should also not be citeable against the present divisional case which has the same disclosure as USSN 09/822,823.

In view of the foregoing, we respectfully request that the objections to the claims under 35 U.S.C. 102 be withdrawn.

**35 U.S.C 103(a)**

The Examiner has objected to the claims 4-10 under 35 U.S.C. 103(a) as being unpatentable over Peters et al. (FASEB Journal 2000) in view of Thomas et al. (6,117,985). We respectfully disagree with the Examiner for the reasons that follow.

Peters et al. is not citeable under 35 U.S.C 103(a) as it is an inventor derived disclosure that occurred less than one year before the effective filing date of the present application. Specifically, Peters et al. was published on April 20, 2000 and as the Examiner has noted, claims 4-10 are entitled to the filing date of the parent application 09/822,823 which is April 2, 2001. In order to dispose of the Peters et al. reference we are enclosing a copy of a declaration under 37 CFR 1.132 of inventor Terry A. Thomas. This declaration is similar to the one that was submitted and accepted under the parent application (09/822,823).

As Peters et al. is not citeable, Thomas et al. alone does not render the claims obvious as it in no way discloses or remotely suggests that an immunosetting method as claimed in the present application. In view of the foregoing, we respectfully request that the objections to the claims under 35 U.S.C 103(a) be withdrawn.

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication of that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater

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detail, he is kindly requested to contact the undersigned by telephone at (416) 957-1682 at his convenience.

Respectfully submitted,

BERESKIN & PARR

By



Micheline Gravelle  
Reg. No. 40,261

Bereskin & Parr  
Box 401, 40 King Street West  
Toronto, Ontario  
Canada M5H 3Y2  
Tel: 416-957-1682  
Fax: 416-361-1398